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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,741	07/03/2003	John C. S. Koo	31045-101	5633
7590	12/30/2004		EXAMINER	
Joseph G. Swan Mitchell Silberberg & Knupp LLP 11377 West Olympic Boulevard Los Angeles, CA 90064			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/613,741	KOO, JOHN C. S.	
	Examiner	Art Unit	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/10/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in–

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-4, 6, 11-12, 19-21 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Loughran US 2004/0163190 (Loughran '190). Loughran '190 discloses all the limitations of the claims including the following: a shoe 10 comprising a bottom surface 40 that is adjacent to the ground in normal use and has at least some indentations (see Figures 2A-2C), with lower extending portions between the indentations (indentations are lower portions of outsole while lower extending portions are ridges in outsole); a sole 40 that forms at least a portion of the bottom surface; an upper portion 46 extending above the sole; a plurality of small particles 26 bonded to at least some of the lower extending portions; at least a portion of the indentations is not coated with the small particles (see Area between forefoot and heel in Figures 2A-2C, where lead line 40 points); at least 1,000 small particles are bonded to the at least some of the lower extending portions (see Figure 3, only a single lower portion shown); the small particles are bonded to the at least some of the lower extending portions using adhesive; the small particles are bonded to the at least some of the lower extending portions by embedding the small particles directly into the bottom surface using at least one of heat and pressure (see

paragraph 0028); the particles have been applied using a flocking technique (see Figure 2B); the small particles have been bonded directly onto the at least some of the lower extending portions (see paragraph 0030); the sole is sufficiently durable for commercial acceptable outdoor use (see paragraph 0027, used in fishing boot); the outsole is comprised of at least one of rubber (see last two lines of paragraph 0029); the small particles cover at least 50% of the portion of the bottom surface that normally comes into contact with the ground (see Figures 2C and 4C); the small particles are bonded using a temporary adhesive that allows the particles to wear off during normal outdoor use (see last lines of paragraph 0027); the sole is sufficiently strong for commercially acceptable outdoor use (use on fishing boots).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 8 10, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loughran US 2004/0163190 as applied above in view of Official Notice. Loughran '190 discloses all the limitations substantially as claimed except for the particle material being made of natural or synthetic leather, natural or synthetic rubber, plastic, the temporary adhesive allows the particles to wear off within no more than 3 days or 3 weeks when worn outdoors. Official Notice is taken that it is well known within the art of anti-slip material to use natural or synthetic leather, natural or synthetic rubber or plastic particles to prevent slipping of one surface on

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another. Furthermore, since Loughran '190 teaches that the gripping surface wears off after time, it would have been well within the skill of one of ordinary skill in the art to find an adhesive that would allow for the particles to fall off after a desired time.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loughran '190 as applied to claim 1 above, in view of Kester 4,356,643. Loughran '190 as applied to claim 2 above discloses all the limitations substantially as claimed except for the small particles being made of fabric. Kester '643 teaches that particulate material used to aid in gripping a slippery surface can be made of fabric material (see col. 2, lines 6-15). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the particles attached to the sole of Loughran '190 out of fabric, as taught by Kester '643, to aid in gaining grip on a slippery surface. The fabric allowing the gaining of grip without being coarse to injure another person or the surface

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loughran '190 as applied to claim 1 above in view of Bible 4,779,360. Loughran '190 as applied to claim 1 above discloses all the limitations of the claim except for the particles comprising metal. Bible '360 teaches that grit material used to gain grip on slippery surfaces can be made of aluminum oxide, silicon carbide or tungsten carbide (i.e. metals) for their durability, less tendency to crumble and their hardness to scratch or furrow up metallic slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the grit particles of Loughran '190 out of metal, as taught by Bible '360, to aid in gaining grip on metallic or rough surfaces.

7. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being obvious over Loughran '190 as applied to claim 1 above. Loughran '190 discloses all the limitations of the claims except for the ASTM tear resistance and abrasion resistance requirements. It appears that since these requirements are standards, it would be well within the skill of one of ordinary skill in the art to make a sole to meet these requirements. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of Loughran '190 meet the tear and abrasion resistance standards.

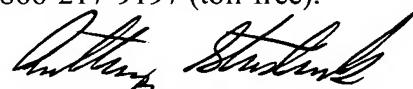
Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is (571) 272-4561. The examiner can normally be reached on Monday through Thursday from 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS